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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/609,446
Filing Date: June 27, 2003
Appellant(s): SCHULLER ET AL.

Dalpreet S. Saluja
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/23/2009 appealing from the Office action mailed 2/11/2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

10/389,474 on appeal

10/423,471 on appeal

11/586,816 on appeal

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,578,797	HEWITT et al	11-1996
2002/0178060	SHEEHAN	11-2002

Ishida, AC-3000 Series brochure, 6 pages, published at least as early as
11/26/1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6, 9-22, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797') (US Pat 5578797) further in view Sheehan (US2002/0178060).

Regarding claims 1, 6, 9-10, 14, 16, Hewitt et al ('797') teaches a scale in a perishable store department that accepts identification of a product (i.e. PLU), weighs and prices identified products (such as perishable bagels). The scale prints label portions that include information about the identified product, a price for the weighed product and a barcode for easily identifying the product and its price at the POS as is

generally known [fig 6A]. Hewitt et al ('797') also teaches a label portion that includes incentive identifying information - an incentive coupon for a discount on a product different from, but related to the weighed product; the coupon has a barcode for easy identification and redemption at the POS [col 4: lines 47-52, 5:1-4, 20-23]. The customer buying the bagels and choosing to also purchase the incentive cream cheese presents both products and the coupon which results in an automatic discount as is generally accepted with electronic POS systems. Regarding the language that the printed "incentive identifying information is other than any incentive code", Hewitt et al ('797') indeed teaches incentive information printed in a narrative, human-friendly form (".50 on one 9oz packet of BEST FOODS CAJUN SPICES") so that the customer can be alerted to the offer and can add the incentive item to his cart. This information is taken to be a label portion that is "code-free". However, the definition in applicant's specification is taken to define the "code-free" claim limitation as one where there is no coupon code or coupon barcode to enter at the POS – the originating product code is sufficient to index the related incentive(s).

"In this implementation the incentive information is preferably "incentive code free," meaning that the incentive information does not include a coupon bar code or other incentive specific code that needs to be input during checkout." [SPEC, paragraph 0022]

The printed matter on the label (or lack of printed code) could be taken to be non-functional descriptive material unless applicant also claims steps/functionality/hardware that can accomplish the automated incentive discounting without the need for a separate incentive code or barcode – the claims are however taken to include this

necessary steps/functionality/hardware. In this manner, Hewitt et al ('797') does not teach coupons redeemed without some sort of coupon-specific code or barcode entered at the POS. Sheehan however teaches the concept of electronic coupons which are associated with an identifier. In this manner, only the parent identifier need be scanned/entered at the POS and the associated coupons can be identified. Sheehan describes the benefit:

[0021] Electronic coupons also save time at the time of checkout and reduce the possibility of error. **Instead of having to enter each coupon manually or scan each paper coupon**, one swipe of a smart card or **one check of a centralized database (performed, perhaps, during a credit check) would allow all appropriate electronic coupons to be processed.**

The processing and redemption of the quick, accurate and convenient electronic coupons is accomplished by recognizing the products presented for purchase and by detecting matches in a database of coupons/incentives that specify the identities of required products. If there is a match (i.e. the consumer is buying the appropriate products), the purchase is automatically discounted without requiring the consumers to carry, present or scan coupons at the point of purchase.

[0116] When the consumer proceeds to the retailers and buys a product or service associated with a stored electronic coupon (Operation 1210), and presents their club card (Operation 1212) **the retailer's system accesses the electronic coupon (which may be stored in the retailer's database at the head-end, backend or otherwise) and correlates the coupon against the items purchased (Operation 1214). When a correlation exists, the retailer's system then automatically deducts the coupon from the purchase price and the transaction is completed (Operation 1216).** As such, in this embodiment, an electronic coupon is associated with a specific

retailer (or chain of stores) such that a consumer need only utilize a club card in order to gain the benefit of an electronic coupon.

It would have been obvious to one of ordinary skill at the time of the invention to have stored the incentive offers desired by Hewitt et al ('797') as well as the offers' required products in a database and to have eliminated the need to: print incentive barcodes, carry around the barcodes/coupons, and present the coupon barcode at the POS for scanning, but rather relied upon an incentive/pricing/product database so that the discounts can be realized without the added hassle of paper-based coupons in the manner of and for the benefits associated with Sheehan.

Regarding claims 2-4, 11-12, 17, the label of fig 6A can be reasonably taken to be a single product label including a product portion and a coupon portion. Fig 6A can also be reasonably taken to provide two labels (a product label and a coupon label separated by a perforation boundary). Certainly when the customer separates the label at the perforation as directed by Hewitt et al ('797'), what results is two labels with respective printing on them. Hewitt et al ('797') also teaches displaying coupon information on a display [6:4-10]. This is taken to represent printing incentive information to non-label media.

Regarding claims 5, 13, it would have been obvious to one of ordinary skill at the time of the invention to have offered multiple coupons (such as buy weighed hamburger patties - get a coupon for ketchup and a coupon for mustard), as a mere duplication of parts. MPEP 2144.04. Where giving a coupon is seen as advantageous, one of

ordinary skill would find it predictably advantageous to offer multiple coupons for related items, thus encouraging even more purchases.

Regarding claim 15, Hewitt et al ('797') prints a message encouraging the customer to also purchase the targeted related product. Hewitt et al ('797') identifies the product name and description so that the customer can understand what is being offered. It would have been obvious to one of ordinary skill at the time of the invention to have further explained to the customer where the product is located so as to help the customer find the product being encouraged for purchase. Further, the "BEST FOODS CAJUN SPICES" language acts as information indicating where in the store the item is located – i.e. in the Spices section. Further still, the differences between the incentive information printed by Hewitt et al ('797') and the location information in the claims is only found in the nonfunctional descriptive material and is not functionally related to the structure of the apparatus. The printer and associated structure is provided the same regardless of the content to be printed. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have printed any type of data content.

Regarding claims 18-22, 28, these claims specifically call for a printed "single incentive code" where claim 1 calls for the absence of such an incentive code. However, Hewitt et al ('797') indeed teaches the use of a printed incentive code [see FIG 6A]. It has been previously argued as obvious to have provided multiple incentives

(ketchup, mustard) for a singled weighed product such as hamburger patties. Given the teachings of Sheehan to associate a plurality of electronic coupons with a single parent identifier, such as a club card identifier being associated with plural coupons, it would have been obvious to one of ordinary skill at the time of the invention to have associated the obvious plural incentives (ketchup, mustard coupons) with its parent identifier (the incentive code representative of the weighed/purchased hamburger patties). These are typical one-to-many relationships which are routinely represented and indexed with the types of relational database employed by routinely skilled artisans as well as Sheehan. This is in alignment with the teachings of Sheehan whereby the individual coupon barcodes (ketchup coupon, mustard coupon) need not be each scanned at the POS, but rather a single identifier can be presented and the system can automatically match and identify the associated child coupons. Therefore it would have been obvious to one of ordinary skill at the time of the invention to have scanned a single incentive barcode of Hewitt et al ('797') which enables the system to locate a plurality of eligible coupon offers (ketchup coupon, mustard coupon, etc) in association with the eligible hamburger patties. Further regarding claim 21, it would have been obvious to one of ordinary skill at the time of the invention to have required the customer to present the originating weighed product/productID when redeeming the earned coupon(s). Otherwise, a customer might pretend they wanted to buy the weighed shrimp just to get a coupon for the spices – leading to wasted shrimp product when un-purchased by the customer. One of ordinary skill would recognize the need to verify the qualifying purchase before the related incentive was granted.

Claims 4, 12 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Hewitt et al ('797') in view of Sheehan as above, and further in view of AC-3000 (Ishida AC-3000 Series brochure, 6 pages – cited by applicant 6/27/2003).

Regarding claims 4, 12, AC-3000 teaches the ability for such a scale to print to adhesive labels as well as to receipts. Hewitt et al ('797') also teaches that the targeted coupon need not be printed on the weighed product's label as in fig 6A - it can be merely displayed [6:4-10]. Official notice is also taken that it is well known to print coupons and other incentive information on a receipt. It would have been obvious to one of ordinary skill at the time of the invention to have printed the desired related coupon information on the customer's receipt. Doing so would not require the customer to go to the trouble of tearing the coupon from the product label.

(10) Response to Argument

Applicant argues that claims (such as 1 as well as others) require presentation of both the weighed item and the incentive item and that Hewitt fails to require presentation/purchase of the weighed item. First, there is no requirement that a customer must present both in the claims; the claims merely set forth a system which is capable of applying a price adjustment when both happen to be presented. The claims are silent on the use-case where the weighed item is NOT presented, but the incentive item IS presented. Applicant's arguments regarding the requirements are therefore moot. Nonetheless, one of ordinary skill would expect that most, if not all of the Hewitt

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customers asking for the weighed product would actually go through with presenting the weighed product for purchase; therefore the system of Hewitt is configured to properly and automatically discount when the weighed item and incentive item are presented. As long as a single customer presents both (as most/all would tend to do), then the claims are certainly met. Lastly and as explained in the rejection, it would have been obvious to one of ordinary skill at the time to configure the invention of Hewitt to require the scanning/purchasing of the weighed product (i.e. shrimp) in order to redeem the triggered incentive product's (i.e. Cajun spices) discount. Doing so (requiring purchase of the weighed product) would be an obvious way to prevent fraud as well as prevent customers from weighing shrimp they don't intend to buy, thereby wasting the shrimp – not purchasing the shrimp would therefore not entitle the consumer to the discounted Cajun spices. The couponing art has for years included certain discount schemes where eligibility hinges on purchase of certain products – by one get one free, buy hot dogs, get half off buns, buy shrimp, get spices, etc.

Claim 18 specifically requires the presence of an incentive code – directly the opposite of that in claim 1. This can provide evidence that neither the presence of nor the absence of a code provides criticality to the invention; one of ordinary skill would have found it obvious to have used a code as is known (and taught by Hewitt), or to have not used a specific coupon code (as obvious given Sheehan's teaching that coupons can be "looked up" using other indexes – such as the triggering weighed product).

Applicant argues that regarding claim 18 that Hewitt fails to teach a single code associated with plural incentive items. This is true. Which is why Sheehan was used as a teaching reference to improve that of Hewitt. Given the obvious nature of duplication, it would have been obvious to have offered multiple incentives (ketchup and mustard) for a single purchased item (weighed hamburger). One of ordinary skill would have found it obvious to have indexed these multiple incentive items from a single identifier (the hamburger) in the beneficial manner of Sheehan. Applicant then argues that Sheehan fails to provide a weighing operation, which is true. However as has been repeatedly established, the base reference of Hewitt already provides the weighing operation. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that there is no reason to combine Hewitt and Sheehan. Examiner has laid out much reasoning why the combination is proper. Applicant appears to offers only one reason in support of the argument not to combine: Hewitt has paper coupon with a weighing operation while Sheehan has e-coupons using a club card at the POS. Clearly both are directed to automated coupon systems, representative of analogous art and which are directed to solving discounting problems in automated manners. The references are ripe for combination. In response to applicant's argument that Sheehan is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Applicant argues that claim 22 is separately patentable, yet the reasoning provided is no more convincing than previously addressed arguments. Further it is pointed out that claim 22 is filled with non-functional descriptive material (printed matter of prices, codes, incentives) that does not impart patentable limitations to the claim. Simply creating multiple coupons as per Hewitt in view of would essentially meet the claim; There being no redemption positively required within the claim scope.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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